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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,866	08/31/2001	Ralph Scorza	0117.96	9493

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Janelle S. Graeter  
USDA-ARS-OTT  
Rm. 4-1159  
5601 Sunnyside Ave.  
Beltsville, MD 20705-5131

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661


DATE MAILED: 12/16/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <b>09/942,866</b>	Applicant(s) <b>Scorza et al.</b>
Examiner <b>Anne Marie Grunberg</b>	Art Unit <b>1661</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 31, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☒ Other: 105 Requirement for Information

## **DETAILED ACTION**

### **Drawings**

Applicant is advised that the rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Since the application was submitted prior to October 1, 2001, the drawings as submitted, are acceptable. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at <http://www.uspto.gov>.

### **Arrangement of the Specification**

1. With the passage of the American Inventors' Protection Act, Applicants' attention is drawn to 37 CFR 1.163(c)-(d) which is reproduced below:

37 CFR 1.163. Specification and arrangement of application elements in a plant application.

(c) The specification should include the following sections in order:

- (1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.
- (2) Cross-reference to related applications (unless included in the application data sheet).

- (3) Statement regarding federally sponsored research or development.
- (4) Latin name of the genus and species of the plant claimed.
- (5) Variety denomination.
- (6) Background of the invention.
- (7) Brief summary of the invention.
- (8) Brief description of the drawing.
- (9) Detailed botanical description.
- (10) A single claim.
- (11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

### **Declaration**

The declaration is objected to as it is lacking information required in a plant patent declaration (see 37 CFR 1.162). The declaration must state that the inventor has asexually reproduced the plant. A new declaration is required.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The parentage of the instant variety is unclear. At page 1, lines 20-21, of the specification, it states that 'Bluebyrd' was transformed. At page 2, lines 4 and 12-14, it states that a seed of 'Bluebyrd' was transformed. It would appear that the latter is correct. Applicant should insert at page 1, line 21, --open pollinated seed of-- after "transformation of" or otherwise clarify the discrepancy.

B. It is suggested at page 3, line 20 that "is" is changed to --was-- if the instant plant has indeed been asexually propagated by bud grafting. Additionally, at

page 6, line 2, "Color" should be changed to --Colour-- in keeping with the correct title of the color chart.

C. Applicant makes several references to multiple color designations wherein the color designations are separated by a "-", such as for example, "RHS 197A-D". It is unclear if Applicant is specifying that the color designations reflect a range in color, or if the colors appear at different geographical locations on the organ, or if some individual organs have one color whereas other organs of the same type, on the same plant, have different colors. Applicant should clarify each occurrence of "-", such as in regard to the trunk color, branch color, lower leaf surface color, and fruit flesh color, for example.

D. There are several terms that are unclear or subjective, such as "Large" tree size, "Vigorous" vigor, "moderate to large" trunk size, and "Medium length" petiole. The height and width of the tree at a particular age should be set forth in order to clarify tree size. Vigor may be expressed as the amount of growth in a season and the height and width of the tree at a particular age would satisfy the tree size requirement. The tree trunk size should be measured at a particular height, and the average length of the petiole should be set forth. The sizes may be quantitatively set forth in the specification to provide as complete a botanical description as is reasonably possible.

E. Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary or color chart. As a result, gland color, petiole color, pit cavity color, abaxial and adaxial vein color, style, stigma, pollen, anther, and filament color designations, should be set forth in the specification. Additionally, Applicant should verify that 91B is the correct fruit skin color designation as the color on the photograph does not support this contention.

F. In the interest of providing as complete a botanical description as is reasonably possible, average gland size, petiole length, style, stigma, anther, and filament lengths should be set forth. The specification should also include information regarding whether the plant is self-fertile or whether a pollinator is required. Additionally, chilling requirement and scent should be set forth as well.

G. Applicant needs to verify parentage of the instant plant because the last IDS reference in Plant Cell Reports recites the parent material as seeds of 'Stanley'. It is unclear if clone 'C5' in the article is the same as the instant plant.

H. Chapter VI, Article 20, section (2) of the 1991 UPOV (The International Union for the Protection of New Varieties of Plants) treaty of which the United States



is a member, states that the denomination may not consist solely of figures except where this is an established practice for designating varieties. As a result, it is suggested that Applicant change the name to one that is not entirely numerical or composed of abbreviations.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

### **Claim Rejections**

#### **35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

#### **35 U.S.C. 102(a)**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Scorza et al (Plant Cell Reports, 1994, 14:18-22).

Claim 1 is directed to a plum tree named 'C5' that is resistance to Plum Pox virus (PPV) infection.

Scorza et al teach a plum tree 'C5' that is resistant to PPV infection.

In response to this rejection, Applicant should clarify whether the 'C5' plum in the publication is the same plant as the one described in the specification. If drawn to a different plant, the rejection will be moot, although Applicant should then change the name in order to avoid confusion. If drawn to the same plant, then a KATZ declaration will be required to overcome the rejection.

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a

reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

### ***Information Assessment***

3. Scorza et al teaches a plum tree 'C5' that appears to be the tree of the instant application. The date of publication is more than one year prior to the filing date of the instant application. Information pertaining to sale or other public availability of the claimed variety anywhere in the world more than one year prior to filing in the United States is necessary to determine enablement of the above publication.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a

skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above appears to disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the publication combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the Internet and the Office’s collection of retail catalogs has not revealed any indication that the plant was for sale more than one year prior to the U.S. application. However, the Office’s collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105.

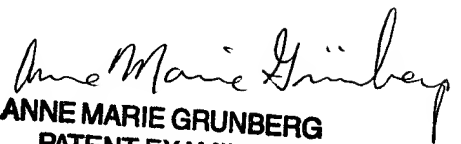
A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

### **Future Correspondence**

Any inquiry concerning this communication from the Examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The Examiner can normally be reached Monday through Thursday from 6:00 am to 3:30 pm and alternate Fridays from 7:00 am to 3:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
**ANNE MARIE GRUNBERG**  
**PATENT EXAMINER**

## ATTACHMENT

### REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, the claimed plant variety, 'C5', was publicly available prior to the filing date of the instant application.

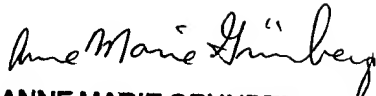
In response to this requirement please provide any information available regarding the first sale or other public distribution of the claimed plant variety **anywhere in the world**, including the date(s) of any sale or other public distribution.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement

under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.

  
**ANNE MARIE GRUNBERG**  
**PATENT EXAMINER**